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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CAROLYNN RAE JOHNSON

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Appeal 2008-2599  
Application 09/994,410<sup>1</sup>  
Technology Center 2600

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Decided: September 19, 2008

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Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,  
and SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

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<sup>1</sup> Application filed November 27, 2001. The real party in interest is Thomson Licensing S.A.

## DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 23-26 and 30-42, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## STATEMENT OF THE CASE

Appellant's invention relates to building a playlist.

Claim 23 is exemplary:

23. A method of creating a video program list comprising the steps of:

presenting a menu including a first program list of recorded programs;

identifying each of said recorded programs in said menu using a title that refers to at least one of a subject matter and an artistic content of said recorded programs;

prompting a user to identify at least one recorded program from said first program list to be included in a second program list;

creating said second program list, including the at least one identified program;

creating an identifier corresponding to said second program list;

including said identifier as a selectable item of said menu.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Okada	US 6,181,870 B1	Jan. 30, 2001
Ellis	US 2002/0174430 A1	Nov. 21, 2002 (filed Feb. 21, 2002)

Claims 23-26, 30-33, 35-39, 41, and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis.

Claims 34 and 40 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ellis and Okada.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).<sup>2</sup>

### ISSUE

The first issue is whether Appellant has shown that the Examiner erred in rejecting claims 23-26, 30-33, 35-39, 41, and 42 under 35 U.S.C. § 102(e). The issue turns on whether Ellis teaches prompting a user to

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<sup>2</sup> Except as will be noted in this opinion, Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. A statement which merely points out what a claim recites is not an argument for separate patentability. *See* 37 C.F.R. § 41.37(c)(1)(vii). In the absence of a separate argument, claims stand or fall with the representative independent claim. *See id.*

identify at least one recorded program from a first program list to be included in a second program list, creating the second program list, creating an identifier corresponding to the second program list, and including the identifier as a selectable item of a menu.

The second issue is whether Appellant has shown that the Examiner erred in rejecting claims 34 and 40 under 35 U.S.C. § 103(a).

### PRINCIPLES OF LAW

On appeal, all timely filed evidence and properly presented arguments are considered by the Board. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a prima facie case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342,

1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

## ANALYSIS

Appellant contends that the Examiner erred in rejecting claims 23-26 and 30-42. Reviewing the record before us, we do not agree. In particular, we find that the Appellant has not shown that the Examiner failed to make a prima facie showing of anticipation with respect to claims 23-26, 30-33, 35-39, 41, and 42, and has not shown that the Examiner failed to make a prima facie showing of obviousness with respect to claims 34 and 40. Appellant failed to meet the burden of overcoming these prima facie showings.

### *§ 102(e) Rejection - Ellis*

Regarding claim 23, Appellant argues (Br. 16-21) that Ellis does not teach the limitations "prompting a user to identify at least one recorded program from said first program list *to be included in a second program list; creating said second program list, including the at least one identified program; creating an identifier corresponding to said second program list; including said identifier as a selectable item of said menu*" (emphasis added), as claimed. We do not agree.

The Examiner "interpreted the term 'program list' to encompass either a listing of programs as presented in the menu in Ellis Fig. 60, or a compiled listing of programs to be played together with a single command of the user." (Ans. 10.) The term "program list" is broad, and we agree that the Examiner's interpretation is reasonable and not inconsistent with the Specification. As noted by the Examiner (Ans. 10), the term "program list" is not found in the Specification. Instead, as further noted by the Examiner (Ans. 10), the Specification uses the term "compilation" (*see, e.g.,*

Spec. 6:4-9) and the amended title includes the term "playlist." We further note that the plain language of the claim does not preclude the "first program list" being modified so as to become a "second program list." In other words, the claim is written broadly enough so that a second program list may be created by modifying the first program list.

With this interpretation, we agree with the Examiner that Ellis teaches the disputed limitations. (Ans. 4-5, 10-13; Ellis, paragraph [0378], Fig. 60.) In particular, we agree that Ellis teaches a first program list by teaching a menu of programs 9618 in Figure 60 and teaches a second program list by teaching a combined recording created by the user highlighting programs and selecting the "combine before" 9620 or the "combine after" 9622 option. (Ans. 10-11; Ellis, paragraph [0378], Fig. 60.)

Thus, we agree with the Examiner that Ellis teaches prompting a user to identify at least one recorded program from the first program list to be included in a second program list. In particular, Ellis teaches that, after a user moves a highlight window over a listing in recording listing 9618, the user can select either the "combine after" option 9620 or the "combine before" option 9622 for the recording identified in the listing bar. (Ans. 4; Ellis, paragraph [0378], Fig. 60.) We also agree with the Examiner that Ellis teaches creating a second program list, including the at least one identified program, by teaching that a user presses an "OK" key to cause the recording for the particular listing to be combined with the currently selected recording. (*Id.*) We further agree with the Examiner that Ellis teaches creating an identifier corresponding to the second program list and including the identifier as a selectable item of a menu by teaching that the combined recording can have a name chosen by the user or the user may be allowed to



enter a new name for the combination. (Ans. 4-5; Ellis, paragraph [0378], Fig. 60.)

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 23 under 35 U.S.C. § 102(e). Appellant argued independent claims 30 and 31 on the same basis as independent claim 23 (Br. 23-24), and we conclude that Appellant has not shown that the Examiner erred in rejecting independent claims 30 and 31 for the same reasons discussed with respect to independent claim 23.

Appellant argues each of dependent claims 24-26, 32, 33, 35-39, 41, and 42 separately. (Br. 21-34.) However, for each claim, Appellant merely argues that the claim is allowable for the same reasons as the independent claim from which it depends. (*Id.*) Also, for each claim, Appellant restates what the claim recites and makes the bare allegation that Ellis does not disclose that limitation. (*Id.*) However, the Examiner has set forth an explanation of how Ellis meets every limitation of dependent claims 24-26, 32, 33, 35-39, 41, and 42. (Ans. 5-8, 13-19.) Appellant has not demonstrated that the Examiner erred in finding the claims anticipated by Ellis. For instance, Appellant has not presented evidence or explained why Ellis does not teach the claim limitations as found by the Examiner. Thus, Appellant has failed to demonstrate error in the Examiner's findings.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 24-26, 32, 33, 35-39, 41, and 42 under 35 U.S.C. § 102(e).

*§ 103 Rejection - Ellis / Okada*

With respect to claims 34 and 40, Appellant argues that these claims are not unpatentable over the applied references for the reasons previously argued with respect to independent claims 23 and 31. (Br. 35-39.)

Appellant also argues that Okada does not remedy the alleged deficiencies of Ellis. (*Id.*) We do not agree.

As discussed, Appellant has not shown any deficiencies in the teachings of Ellis with respect to independent claims 23 and 31. In addition, as noted by the Examiner (Ans. 9, 19-20), Okada was cited for the teaching of transferring a user-defined chain from one medium to a second medium in response to a single user selection of the identifier. Because Appellant has not provided any arguments regarding the teachings of Okada as found by the Examiner, nor any additional arguments regarding claims 23 and 31, we will sustain the rejection for the reasons discussed with respect to independent claims 23 and 31, from which claims 34 and 40 depend.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 34 and 40 under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

We conclude that:

(1) Appellant has not shown that the Examiner erred in rejecting claims 23-26, 30-33, 35-39, 41, and 42 for anticipation under 35 U.S.C. § 102(e).

(2) Appellant has not shown that the Examiner erred in rejecting claim 34 and 40 for obviousness under 35 U.S.C. § 103.

DECISION

The rejection of claims 23-26, 30-33, 35-39, 41, and 42 for anticipation under 35 U.S.C. § 102(e) is affirmed.

The rejection of claims 34 and 40 for obviousness under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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